

Appl. No. 10/052,741  
Atty. Docket No. G-269ML (CP-1228)  
Amdt. dated 08/20/2004  
Reply to Office Action of 02/20/2004  
Customer No. 27752

### REMARKS

#### Application Amendments

Claims 1-6 are pending in the present application. No additional claims fee is believed to be due.

Claims 7-24 have been withdrawn as a result of an earlier restriction requirement, and may be canceled upon notice of allowable subject matter.

Claims 1 and 2 have been amended as shown above to delete "a hydrogen atom" from the Markush group from which  $R_2$  is selected. Support for these amendments can be found in original claims 1 and 2 as well as at page 3, lines 6-13 and page 4, lines 1-24 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

#### Rejection Under 35 USC 102(b) and 103(a) Over US Patent No. 5,704,948 to Terranova et al.

Claims 1 and 2 remain rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being obvious over, US Patent No. 5,704,948 to Terranova et al. ("Terranova"). The Examiner asserts Terranova teaches that aminoethyl compounds are useful and specifically discloses the utility of the homologous aminomethyl compound, and, thus, Applicants' claimed compounds are immediately envisaged by one of ordinary skill in the art. The Examiner also asserts it would have been obvious to one of ordinary skill in the art to make Applicants' claimed compounds because Terranova teaches a broad expectation of success among all of the compounds disclosed. However, the Examiner states that Applicants' compounds as claimed in claims 3-6 would be allowable over Terranova because Terranova does not disclose or motivate the preparation of the compounds as claimed in claims 3-6.

As currently amended, Applicants' claims 1 and 2 require that only  $R_1$ , and not  $R_2$ , may be hydrogen. Although Terranova discloses  $C_1$ - $C_4$  aminoalkyl as useful  $R_{13}$  substituents in Formula (IV) of Terranova, the only aminoalkyl compound specifically named is 4-amino-2-aminomethylphenol. Terranova does not disclose  $C_1$ - $C_4$  *substituted*-aminoalkyl as useful, nor does it specifically name a compound having a *substituted*-aminoalkyl substituent. Therefore, Applicants' claimed compounds would not be immediately envisaged by one of ordinary skill in the art, and, accordingly, are not anticipated by Terranova.

Applicants' claimed compounds, as claimed in the currently amended claims, also would not have been obvious to one of ordinary skill in the art in view of Terranova. The Examiner asserts that Terranova teaches a broad expectation of success among all of the oxidation base compounds disclosed. But, as stated above, Terranova does not disclose  $C_1$ - $C_4$  *substituted*-aminoalkyl as useful  $R_{13}$  substituents in Formula (IV) of Terranova. Terranova also fails to

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suggest the use of *substituted*-aminoalkyl substituents because it only specifically names 4-amino-2-aminomethylphenol, which contains an *unsubstituted*-aminoalkyl substituent. Although the statement in Terranova that the nature of the oxidation bases which can be used in the dyeing composition according to the invention is not critical may be interpreted as a teaching of a broad expectation of success among all of the oxidation bases disclosed, it is not a statement which would motivate one of skill in the art to modify the disclosed oxidation bases. Therefore, Terranova fails to teach or suggest all of the limitations of Applicants' claimed compounds. Accordingly, it would not have been obvious to one of skill in the art to make a selection from the disclosure of Terranova or to modify the compounds disclosed in Terranova in order to achieve Applicants' claimed compounds.

Furthermore, the Examiner has stated that the compounds as claimed in claims 3-6 are allowable over Terranova because Terranova does not disclose or motivate the preparation of such compounds. Applicants respectfully submit that the current amendments to claims 1 and 2 are in accord with the Examiner's statement of allowable subject matter with respect to claims 3-6 and, as a result, that Terranova does not disclose or motivate the preparation of compounds as claimed in currently amended claims 1 and 2 as well as in claims 3-6.

Accordingly, Applicants' claims 1 and 2 are novel and nonobvious over Terranova.

#### CONCLUSION

In light of the amendments and remarks presented herein, it is requested that the Examiner enter the current amendments and reconsider and withdraw the present rejections. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application and allowance of Claims 1-6.

Respectfully submitted,

Mu'III Lim et al.

By M. Dressman  
Marianne Dressman  
Attorney for Applicant(s)  
Registration No. 42,498  
(513) 626-0673

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